

Amendments to the Drawings

The attached sheets of drawings include changes to Figures 1 and 2. These sheets which include Figures 1 and 2, replace the original sheets including Figures 1 and 2.

Attachment: Replacement Sheets

REMARKS/ARGUMENTS

This amendment is filed in response to the office action dated November 25, 2009. Claims 1, 3 and 5-14 are pending in this application. Claims 1, 3 and 5-14 are rejected. The drawings are objected to by the Examiner. Support for the amendments can be found throughout the specification. No new matter has been presented. Entry of the amendment is respectfully requested because it is believed to place the application into condition for allowance or reduce the number of issues on appeal.

Allowable Subject Matter

Applicants note with appreciation that claims 7-9, 12 and 14 have been indicated as containing allowable subject matter.

Drawing Objections

On page 2 of the Office Action the drawings stand objected to for allegedly failing to comply with 37 CFR 1.84(p)(5). The alleged grounds, along with applicants' response (in italics) are:

(1) because they include the following reference character(s), added by Applicant in the replacement drawings, but not mentioned in the specification: 51 and 52. *The specification was amended in the previous reply in the paragraph beginning on page 18, line 24 to include reference numbers 51 and 52.*

(2) newly added element 51, supposedly representing a measurement device (such as a spectrometer) cannot be disposed as shown because the center of the apparatus accommodates slide insert mechanism 15 (Figure 3), and the specification describes the spectrometer as being located below the incubator rotor (see [00611]). *Enclosed amended Figure 1 shows element 51 in outline to indicate that it is not visible. Also the specification has been amended at page 18, beginning at line 24 to show that element 51 is hidden.*

(3) the drawings do not show the following essential features recited in the amended claims:

(a) the probe tip dispenser containing probe tips. *Figure 2 has been amended to show a probe tip 6 contained within probe tip dispenser 2a.*

(b) the test element holder containing cup-shaped wells. *The cup-shaped wells are shown as black box 54 in Figure 1 and are clearly in the test element holder.*

(c) the removable holder comprising immunoassay test reaction container. *This feature has been removed from the claims.*

In view of the foregoing remarks and amendments reconsideration and withdrawal of the drawing objections are respectfully requested.

Claim Rejections – 35 USC §112, second paragraph:

Claims 1, 3 and 5 -14 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the foregoing amendments and following remarks, reconsideration and withdrawal of the rejection are respectfully requested.

The Office Action takes the position that in claim 1 "line of travel" lacks antecedent basis, since the preceding lines of the claim do not set forth this feature. In an attempt to further prosecution, applicants have amended the claims to specifically recite that each of the probe tip dispenser containing probe tips, fluid sample section containing the sample to be analyzed and test element recess containing the one or more test elements have a line of travel and each of these lines of travel are on the same line of travel.

The Office Action continues to take the position "that it is unclear what structural features of the removable holder and/or test elements would allow the liquid dispense or aspirating station to act upon the test elements 'while the test elements are in the recess'" citing to MPEP 2172.01.

Applicants are unclear as to the basis of this rejection. As noted above, the Office Action refers to MPEP 2172.01. Section 2172.01 states, in part:

A claim which omits matter disclosed to be essential to the invention as ***described in the specification or in other statements of record*** may be rejected under 35 U.S.C. 112, first paragraph as not enabling.

In addition, a claim which fails to interrelate essential elements of the invention ***as defined by applicant(s) in the specification*** may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention.

(emphasis added). Applicants are unclear what essential elements disclosed in the specification are missing from the claim. The liquid dispense or aspirating station can act on the test element by virtue of the liquid dispense or aspirating station being on the same line of travel as claimed. The Examiner's input and suggestions regarding this point are respectfully requested.

Claim Rejections – 35 USC §103:

Claims 1, 3, 5-6, 10-11 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. (US 6190617) ("Clark"). Reconsideration and withdrawal of the rejection are respectfully requested.

The Office Action states that Clark discloses the claimed invention except that the "sample container segments are disclosed to hold only sample tubes 620 that contain samples." However, the Office Action takes the position:

it would have been within the ordinary skill of an artisan at the time the invention was made to have employed some of the recesses in the modified segments of Clark for additionally holding test tubes ['test elements'] and probe tips, in order to reduce sample processing time by arranging the fluid handling components in a closer proximity and to gain more flexibility for conducting assays of various protocols which would allow to further diversify the tests to be performed.

Applicants respectfully disagree with this position and submit that one of ordinary skill in the art would not have been motivated to modify the analyzer of Clark in the manner proposed by the Office Action and that such modifications would result in Clark's analyzer being inoperable.

The Office Action equates the sample container segments 600 of Clark with the claimed removable holders. The sample container segments 600 of Clark shown in Figures 36, 37 and 38 and described in the specification at column 48, lines 46 et seq. contain tubular sleeves 609 and opening 606 to hold sample containers 620 (Figure 39). There is nothing in Clark to suggest that the sample container segments 600 should contain anything other than sample container holders 120.

Notwithstanding the foregoing, the Office Action asserts the sample container holders 120 (termed “sample tubes” or “test tubes” in the Office Action) can be used as “test elements” for conducting assays by adding relevant reagents, despite a complete lack of evidence showing that the sample container holders 120 would be suitable for such a use.

After equating certain sample container holders 120 as test elements, the Office Action, as quoted above, asserts it would have been within the realm of one of ordinary skill in the art to use some of the recesses (i.e., tubular sleeves 609 and openings 606) of the sample container segments 600 to hold the already modified sample container holders as test elements (see above) and probe tips to arrive at the claimed invention.

First, the Office Action has failed to show any evidence that the probe tip 108 is a removable probe tip such that a probe tip holder would have been necessary. Applicants have reviewed the entirety of Clark and can find no reference to the probe tip being removable. Since non-disposable probes are common on clinical analyzers one of ordinary skill in the art would not assume the probe tip 108 is in fact removable. Quite the opposite, the assumption would be the probe tip 108 is non-disposable since the drawings do not show the tip as being separate from the rest of the pipetting probe and the specification is silent as to the probe tip 108 being removable. Accordingly, since there is no evidence the probe tip is removable, there would have been no reason to have a probe tip holder and hence no motivation for the recesses of the sample container segments to be probe tip holders as claimed.

Second, making the modification proposed by the Office Action would result in the “test element” (i.e., the test sample container 120) being held by container holder 120 in sample carousel 28 (see Figure 4A). However, having the “test element” in

sample carousel 28 would make it impossible to transfer the “test element” to process carousel 42 which is the earliest point any sample measurement can occur.

Clark clearly teaches that only reaction vessels 34 are transferred to process carousel 42 where the reaction vessels may be directly read by FPIA processing lamp 54 or the contents of the reaction vessels are further transferred to MEIA cartridge 68 for sample measurement by MEIA reader 74 (See Clark column 20, line 7 to column 8, line 8). Accordingly, having the test element “stuck” in sample carousel 28 would render the analyzer of Clark inoperable. As such, the claimed invention would not have been *prima facie* obvious and reconsideration and withdrawal of the rejection are respectfully requested.

Based on the foregoing, applicant believes the application is now in condition for allowance. Favorable reconsideration and notice of allowance are solicited. If any questions arise which can be disposed through interview, the Examiner is encouraged to contact applicants’ attorney at the telephone number listed below.

Please charge any fees, which may be required for this submission to Johnson & Johnson Deposit Account No. 10-0750/CDS0290USNPUSNP/TJB.

Respectfully submitted,
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